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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/062,113 04/17/98 GOTO

M FJN-060DV

EXAMINER

HM12/0124

PATENT ADMINISTRATOR
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ROMEN, D.	
ART UNIT	PAPER NUMBER

1647

DATE MAILED:

01/24/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/062,113

Applicant(s)

Goto et al.

Examiner

David Romeo

Group Art Unit

1647



☒ Responsive to communication(s) filed on 9 Nov 2000

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 31-34 and 41-46 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 31-34 and 41-46 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Art Unit: 1647

DETAILED ACTION

1. The amendment filed 11/09/00 (Paper No. 15) has been entered. Claims 32-34, 41-46 are pending and being examined.

2. Any objection and/or rejection of record that is not maintained and/or repeated in this Office action is withdrawn. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

3. The abstract of the disclosure is objected to because it is not a single paragraph. A substitute abstract on a separate sheet is required. See MPEP § 608.01(b). It is acknowledged that Applicants will correct the abstract in a substitute specification.

4. A substitute specification excluding claims is required pursuant to 37 CFR 1.125(a) because the interlineations or cancellations made in the specification could lead to confusion and mistake during the issue and printing processes. Accordingly, the specification is required to be rewritten before passing the case to issue. See 37 CFR 1.125 and MPEP § 608.01(q). It is acknowledged that Applicants will provide a substitute specification upon the identification of allowable subject matter.

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5. The application is not fully in compliance the sequence rules, 37 C.F.R. § 1.821-1.825. Correction is required. It is acknowledged that Applicants will bring the application into compliance in a substitute specification.

6. Claims 32-34, 41-46 are rejected under 35 U.S.C. 112, first paragraph, as containing
5 subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Although Applicants indicate that the claims were amended as suggested by the Office action, the claims were not so amended. It is suggested that the claims recite either "DNA molecule" or "polynucleotide" instead of reciting "cDNA".

10 7. Claims 33, 42, 45 are rejected under 35 U.S.C. § 112, second paragraph, over the recitation of "protein encoded by cDNA" (claim 33) and "protein encoded by a cDNA" (claims 42, 45) because a nucleotide sequence has six reading frames, three forward and three reverse, and encodes at least six different proteins. It is unclear which protein is intended. Although Applicants indicate that the amendments as suggested by the Office action should obviate this
15 grounds of rejection, the last Office action did not make a suggested amendment to overcome the rejection and Applicants' amendments do not appear to address the rejection.

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8. Claims 32-34, 41-46 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-4, 6 of copending Application No. 08915004 in view of Mark (a12)¹. Applicants' request to hold this rejection in abeyance until allowable subject matter has been identified is acknowledged. However, there are
5 no provisions for holding a rejection in abeyance.

9. Claims 32-34, 41-46 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 5 of copending Application No. 09051670 in view of Mark (a12). Applicants' request to hold this rejection in abeyance until allowable subject matter has been identified is acknowledged. However, there are no provisions
10 for holding a rejection in abeyance.

Conclusion

10. No claims are allowable.

¹Citations by the examiner are in an alphanumeric format, such as "(a1)", wherein the "a" refers to the reference cited on the Notice of References Cited, PTO-892, and the "1" refers to the Paper No. to which the Notice of References Cited, PTO-892, is attached.

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11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

ANY INQUIRY CONCERNING THIS COMMUNICATION OR EARLIER COMMUNICATIONS FROM THE EXAMINER SHOULD BE DIRECTED TO DAVID S. ROMEO WHOSE TELEPHONE NUMBER IS (703) 305-4050. THE EXAMINER CAN NORMALLY BE REACHED ON MONDAY THROUGH FRIDAY FROM 6:45 A.M. TO 3:15 P.M.

IF ATTEMPTS TO REACH THE EXAMINER BY TELEPHONE ARE UNSUCCESSFUL, THE EXAMINER'S SUPERVISOR, GARY KUNZ, CAN BE REACHED ON (703) 308-4623.

OFFICIAL PAPERS FILED BY FAX SHOULD BE DIRECTED TO (703) 308-4242.

FAXED DRAFT OR INFORMAL COMMUNICATIONS SHOULD BE DIRECTED TO THE EXAMINER AT (703) 308-0294.

ANY INQUIRY OF A GENERAL NATURE OR RELATING TO THE STATUS OF THIS APPLICATION OR PROCEEDING SHOULD BE DIRECTED TO THE GROUP RECEPTIONIST WHOSE TELEPHONE NUMBER IS (703) 308-0196.

David Romeo

DAVID ROMEO
PRIMARY EXAMINER
ART UNIT 1647

JANUARY 23, 2001